UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,618	06/13/2000	Jay S. Walker	00-012	5604

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EXAMINER
BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
3628	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/592,618	WALKER ET AL.
	Examiner	Art Unit	
	Igor N. Borissov	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 June 2007*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12,14-28,30-33,35-53,59-64 and 81-108* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *59-64,81-87,102-105 and 108* is/are allowed.

6)☒ Claim(s) *1-12, 14-28, 88-101, 106 and 107* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

Response to Amendment

Amendment received on 7/27/2006 is acknowledged and entered. Claim 34 has been canceled. Claims 1-2, 5, 22, 30, 32, 51-52, 88-91, and 96-99 have been amended. Claims 1-12, 14-28, 30-53, 59-64 and 81-108 are currently pending in the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 30, 32, 33, 35-38, 40-44 and 46 are rejected under 35 U.S.C. 102(a) as being anticipated by Shermack (Some Customers Willing to Pay for Priveleges).

Shermack, which appears to be published in December, 1999, teaches an existing practice between retailers to charge customers to joint their loyalty clubs, said practice comprising:

Independent Claim

As per claims 30,

- receiving transaction information, the transaction information been associated with a transaction having a transaction price (the term "customer" in Shermack indicates at lest one transaction; page 1, Abstract; see examiner's numeration at the bottom of each page);

- determining a benefit and a qualifying action for said benefit, said benefit based at least in part on said information (a gift certificate applicable towards future meals; page 1, Text, 3rd paragraph);

- determining a price for said benefit, wherein said price is a non-zero monetary amount ($25 fee; page 1, Text, 3rd paragraph);

- selling said benefit at said benefit price to a customer ($25 fee; page 1, Text, 3rd paragraph);

- applying said benefit during a future transaction (Abstract).

Dependent Claims

As per claim 32, said method, further comprising at least one of the following: retrieving benefit information; offering said benefit for sale at said price; receiving an indication of a purchase of said benefit; and receiving an indication of a customer's agreement to purchase said benefit (see reasoning applied to claim 1).

As per claim 33, said method, further comprising at least one of the following: determining an available subsidy (gift certificate); receiving a subsidy amount; and determining a margin between a price and a subsidy amount (see reasoning applied to claim 1).

As per claim 35, said method, further comprising at least one of the following: establishing a condition on said benefit (gift certificate); determining a condition associated with said benefit; and providing an indication of a condition associated with said benefit (see reasoning applied to claim 1).

As per claim 36, said method, further comprising at least one of the following: receiving an indication of a receiver of said benefit; canceling said benefit; changing said benefit; and redeeming said benefit (see reasoning applied to claim 1).

As per claim 37, said method, further comprising at least one of the following: receiving a customer identifier; receiving a group identifier; receiving a customer device identifier; receiving a payment identifier; receiving a retailer identifier; receiving a benefit identifier; receiving a service identifier; and receiving a product identifier (see reasoning applied to claim 1).

As per claim 38, said method, further comprising at least one of the following: redeeming a previously determined benefit; receiving a request to redeem said benefit; aggregating said benefit with a previously determined benefit (see reasoning applied to claim 1).

As per claim 41, associating a qualifying action (purchasing an identified product/meal) with said benefit; see reasoning applied for claim 30.

As per claim 42-44,

receiving an indication of a completion of said qualifying action providing said benefit after receiving said indication;

arranging for said benefit to be provided after receiving said indication (see reasoning applied for claim 30).

As per claim 46, see reasoning applied for claim 30.

Claims 1-4, 6-9, 11, 12, 14-25, 28, 31, 47-53, and 88-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shermack (Some Customers Willing to Pay for Priveleges).

Independent Claims

As per claim 1,

- receiving information relating to a first transaction, the first transaction been associated with a first price (the term "customer" in Shermack indicates at lest one transaction; page 1, Abstract; see examiner's numeration at the bottom of each page);

- determining a benefit, said benefit based at least in part on said information (a gift certificate applicable towards future meals; page 1, Text, 3rd paragraph);

- determining a price of said benefit, wherein said price is non-zero monetary amount ($25 fee; page 1, Text, 3rd paragraph);

- charging the price to a customer associated with the first transaction ($25 fee; page 1, Text, 3rd paragraph);

- applying said benefit during future transaction [0063].

Shermack does not teach that said future transaction is a second transaction.

However, it would have been obvious matter of business choice to one having ordinary skill in the art at the time the invention was made to modify Shermack to include that said future transaction is a second transaction, to address the specifics of each restaurant location and local demographics.

As per claims 47, 49,

- conducting a transaction for a purchase of a first service (meal), the purchase been associated with a transaction price (the term "customer" in Shermack indicates at lest one transaction; page 1, Abstract; see examiner's numeration at the bottom of each page);

- determining a benefit during said transaction, said benefit associated with a future purchase of another service (meal) and said benefit having an associated benefit price, wherein said benefit price is a non-zero monetary amount (a gift certificate applicable towards future meals; page 1, Text, 3rd paragraph);

- providing to a customer said benefit at said price, thereby charging the price to the consumer ($25 fee; page 1, Text, 3rd paragraph);

- applying said benefit during a second transaction (Abstract).

Shermack does not teach that said another service (meal) is a second service (meal).

However, it would have been obvious matter of business choice to one having ordinary skill in the art at the time the invention was made to modify Shermack to include that said another service (meal) is a second service (meal), to address the specifics of each restaurant location and local demographics.

Also, Shermack does not specifically teach that providing, to a customer said benefit is conducted during said transaction. However, it would have been obvious matter of business choice to one having ordinary skill in the art at the time the invention was made to modify Shermack to include that providing, to a customer said benefit is conducted during said transaction, to address the specifics of each restaurant location and local demographics.

As per claims 51, 52,

- receiving information relating to a first transaction, the first transaction been associated with a first transaction price (the term "customer" in Shermack indicates at

lest one transaction; page 1, Abstract; see examiner's numeration at the bottom of each page);

- determining a benefit, said benefit based at least in part on said information and having an associated price, wherein said price is a non-zero monetary amount (a gift certificate applicable towards future meals; page 1, Text, 3rd paragraph);

- providing, to a customer associated with the first transaction, said benefit at said benefit price, thereby charging the price to the consumer ($25 fee; page 1, Text, 3rd paragraph);

- applying said benefit during a future transaction, wherein said benefit is applicable by the customer during said second transaction only if said customer has completed a qualifying action associated with said benefit (Abstract).

Shermack does not teach that said future transaction is a second transaction.

However, it would have been obvious matter of business choice to one having ordinary skill in the art at the time the invention was made to modify Shermack to include that said future transaction is a second transaction, to address the specifics of each restaurant location and local demographics.

Also, Shermack does not specifically teach that providing, to a customer said benefit is conducted during said transaction. However, it would have been obvious matter of business choice to one having ordinary skill in the art at the time the invention was made to modify Shermack to include that providing, to a customer said benefit is conducted during said transaction, to address the specifics of each restaurant location and local demographics.

As per claims 53,

- receiving information associated with a first transaction, the first transaction been associated with a first transaction price (the term "customer" in Shermack indicates at lest one transaction; page 1, Abstract; see examiner's numeration at the bottom of each page);

- establishing a benefit having a first price, wherein said first price is non-zero monetary amount (a gift certificate applicable towards future meals; page 1, Text, 3rd paragraph);

- selling, to a customer associated with the first transaction, said benefit for said, thereby charging said price to the customer ($25 fee; page 1, Text, 3rd paragraph);

- applying said benefit during a future transaction (Abstract).

Shermack does not teach that said future transaction is a second transaction.

However, it would have been obvious matter of business choice to one having ordinary skill in the art at the time the invention was made to modify Shermack to include that said future transaction is a second transaction, to address the specifics of each restaurant location and local demographics.

Also, Shermack does not specifically teach that providing, to a customer said benefit is conducted during said first transaction. However, it would have been obvious matter of business choice to one having ordinary skill in the art at the time the invention was made to modify Shermack to include that providing, to a customer said benefit is conducted during said first transaction, to address the specifics of each restaurant location and local demographics.

As per claims 88 and 89,

- receiving information relating to a first transaction, the first transaction been associated with a first price (the term "customer" in Shermack indicates at lest one transaction; page 1, Abstract; see examiner's numeration at the bottom of each page);

- determining a benefit, said benefit based at least in part on said information (a gift certificate applicable towards future meals; page 1, Text, 3rd paragraph);

- determining a price of said benefit, wherein said price is non-zero monetary amount ($25 fee; page 1, Text, 3rd paragraph);

- charging the price to a customer associated with the first transaction ($25 fee; page 1, Text, 3rd paragraph);

- applying said benefit during future transaction [0063].

Shermack does not teach that said future transaction is a second transaction.

However, it would have been obvious matter of business choice to one having ordinary skill in the art at the time the invention was made to modify Shermack to include that said future transaction is a second transaction, to address the specifics of each restaurant location and local demographics.

Furthermore, Shermack does not specifically teach a computer. However, it is old and well known that computers are used for processing transactions. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Shermack to include the use of a computer for processing transactions, because it would advantageously allow automate the transaction process.

As per claims 90 and 91,

- receiving transaction information, the transaction information been associated with a transaction having a transaction price (the term "customer" in Shermack indicates at lest one transaction; page 1, Abstract; see examiner's numeration at the bottom of each page);

- determining a benefit and a qualifying action for said benefit, said benefit based at least in part on said information (a gift certificate applicable towards future meals; page 1, Text, 3rd paragraph);

- determining a price for said benefit, wherein said price is a non-zero monetary amount ($25 fee; page 1, Text, 3rd paragraph);

- selling said benefit at said benefit price to a customer ($25 fee; page 1, Text, 3rd paragraph);

- applying said benefit during a future transaction (Abstract).

Shermack does not specifically teach a computer. However, it is old and well known that computers are used for processing transactions. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Shermack to include the use of a computer for processing transactions, because it would advantageously allow automate the transaction process.

As per claims 92-95,

- conducting a transaction for a purchase of a first service (meal), the purchase been associated with a transaction price (the term "customer" in Shermack indicates at lest one transaction; page 1, Abstract; see examiner's numeration at the bottom of each page);

- determining a benefit during said transaction, said benefit associated with a future purchase of another service (meal) and said benefit having an associated benefit price, wherein said benefit price is a non-zero monetary amount (a gift certificate applicable towards future meals; page 1, Text, 3rd paragraph);

- providing to a customer said benefit at said benefit price, thereby charging the price to the consumer ($25 fee; page 1, Text, 3rd paragraph);

- applying said benefit during a second transaction (Abstract).

Shermack does not teach that said another service (meal) is a second service (meal).

However, it would have been obvious matter of business choice to one having ordinary skill in the art at the time the invention was made to modify Shermack to include that said another service (meal) is a second service (meal), to address the specifics of each restaurant location and local demographics.

Also, Shermack does not specifically teach that providing, to a customer said benefit is conducted during said transaction.

However, it would have been obvious matter of business choice to one having ordinary skill in the art at the time the invention was made to modify Shermack to include that providing, to a customer said benefit is conducted during said transaction, to address the specifics of each restaurant location and local demographics.

Also, Shermack does not specifically teach a computer. However, it is old and well known that computers are used for processing transactions. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Shermack to include the use of a computer for processing transactions, because it would advantageously allow automate the transaction process.

As per claims 96-99,

- receiving information relating to a first transaction, the first transaction been associated with a first transaction price (the term "customer" in Shermack indicates at lest one transaction; page 1, Abstract; see examiner's numeration at the bottom of each page);

- determining a benefit, said benefit based at least in part on said information and having an associated price, wherein said price is a non-zero monetary amount (a gift certificate applicable towards future meals; page 1, Text, 3rd paragraph);

- providing, to a customer associated with the first transaction, said benefit at said price during said transaction, thereby charging the price to the consumer ($25 fee; page 1, Text, 3rd paragraph);

- applying said benefit during a future transaction, wherein said benefit is applicable by the customer during said second transaction only if said customer has completed a qualifying action associated with said benefit (Abstract).

Shermack does not teach that said future transaction is a second transaction.

However, it would have been obvious matter of business choice to one having ordinary skill in the art at the time the invention was made to modify Shermack to include that said future transaction is a second transaction, to address the specifics of each restaurant location and local demographics.

Also, Shermack does not specifically teach that providing, to a customer said benefit is conducted during said transaction. However, it would have been obvious matter of business choice to one having ordinary skill in the art at the time the invention was made to modify Shermack to include that providing, to a customer said benefit is conducted during said transaction, to address the specifics of each restaurant location and local demographics.

Also, Shermack does not specifically teach a computer. However, it is old and well known that computers are used for processing transactions. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Shermack to include the use of a computer for processing transactions, because it would advantageously allow automate the transaction process.

As per claims 100 and 101,

- receiving information associated with a first transaction, the first transaction been associated with a first transaction price (the term "customer" in Shermack indicates at lest one transaction; page 1, Abstract; see examiner's numeration at the bottom of each page);

- establishing a benefit having a first price, wherein said first price is non-zero monetary amount (a gift certificate applicable towards future meals; page 1, Text, 3rd paragraph);

- selling, to a customer associated with the first transaction, said benefit for said, thereby charging said price to the customer ($25 fee; page 1, Text, 3rd paragraph);

- applying said benefit during a future transaction (Abstract).

Shermack does not teach that said future transaction is a second transaction.

However, it would have been obvious matter of business choice to one having ordinary skill in the art at the time the invention was made to modify Shermack to include that said future transaction is a second transaction, to address the specifics of each restaurant location and local demographics.

Also, Shermack does not specifically teach that providing, to a customer said benefit is conducted during said first transaction. However, it would have been obvious matter of business choice to one having ordinary skill in the art at the time the invention was made to modify Shermack to include that providing, to a customer said benefit is conducted during said first transaction, to address the specifics of each restaurant location and local demographics.

Also, Shermack does not specifically teach a computer. However, it is old and well known that computers are used for processing transactions. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Shermack to include the use of a computer for processing transactions, because it would advantageously allow automate the transaction process.

Dependent Claims

As per claim 2, said method, further comprising at least one of the following: retrieving benefit information; offering said benefit for sale at said price; receiving an indication of a purchase of said benefit; and receiving an indication of a customer's agreement to purchase said benefit (see reasoning applied to claim 1).

As per claims 3, said method, further comprising at least one of the following: determining an available subsidy (gift certificate); receiving a subsidy amount; and determining a margin between a price and a subsidy amount (see reasoning applied to claim 1).

As per claims 4 and 31, said method, further comprising:

- verifying usability of said benefit during said second transaction – obvious feature to prevent fraud.

As per claims 6, said method, further comprising at least one of the following: establishing a condition on said benefit (gift certificate); determining a condition associated with said benefit; and providing an indication of a condition associated with said benefit (see reasoning applied to claim 1).

As per claim 7, said method, further comprising at least one of the following: receiving an indication of a receiver of said benefit; canceling said benefit; changing said benefit; and redeeming said benefit (see reasoning applied to claim 1).

As per claim 8, said method, further comprising at least one of the following: receiving a customer identifier; receiving a group identifier; receiving a customer device identifier; receiving a payment identifier; receiving a retailer identifier; receiving a benefit identifier; receiving a service identifier; and receiving a product identifier (see reasoning applied to claim 1).

As per claim 9, said method, further comprising at least one of the following: redeeming a previously determined benefit; receiving a request to redeem said benefit;

aggregating said benefit with a previously determined benefit (see reasoning applied to claim 1).

As per claims 11-12 and 40, providing a list of at least two benefits; receiving an indication of a selection of one of said at least two benefits; receiving an indication of at least one person to whom said benefit is to be provided – an obvious feature to address the specifics of each restaurant location and local demographics.

As per claims 19, 20-22, 48 and 50, see reasoning applied for claims 1, 47 and 49.

As per claims 14 and 15, associating a qualifying action (purchasing an identified product (meal)) with said benefit (see reasoning applied to claim 1).

As per claims 16-17,

receiving an indication of a completion of said qualifying action;

providing said benefit after receiving said indication;

arranging for said benefit to be provided after receiving said indication (see reasoning applied to claim 1).

As per claim 18, said method, wherein said transaction information includes a customer identifier – an obvious feature to create a loyal customers database.

As per claim 23, said method, wherein said benefit is a previously determined benefit (see reasoning applied for claim 1).

As per claims 24 and 25, providing a receipt (coupon) to a customer, wherein said receipt includes a benefit identifier - an obvious feature to inform the customer about the certificate.

As per claim 28, said method, wherein said benefit cannot be applied during said first transaction (see reasoning applied for claim 1).

As per claims 106 and 107, it is old and well known to use mobile terminal for e-commerce. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Shermack to include that the customer device is mobile terminal, because it would advantageously allow customers to conduct shopping at any convenient for the customers place and time.

Claims 5, 10, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shermack in view of Walker et al. (US 5,970,470).

Dependent Claims

As per claims 5, 10, and 39, Shermack teaches all the limitations of claims 5, 10, and 39, except teaching imposing a penalty or reducing the benefit if a customer does not complete a specific future transaction.

Walker et al. (Walker) teaches a method for establishing and managing subscription purchase agreements, wherein a customer's account may be assessed a penalty in the event that the customer does not honor the purchase terms and conditions (C. 2, L. 63 – C. 3, L. 4).

It would have been obvious to one having ordinary skill in the art to modify Shermack to include imposing a penalty if a customer does not complete a specific future transaction, as disclosed in Walker, because it would advantageously allow to minimize losses incurred by vendors who provide benefits for their customers.

Claims 26-27 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shermack in view of Mindrum et al. (US 4,723,212).

Dependent Claims

As per claims 26-27 and 45, Shermack teaches all the limitations of claims 26-27 and 45, except that the benefit is transferable, and wherein said benefit can be shared by a plurality of people.

Mindrum et al. (Mindrum) teaches a method for dispensing discount coupons, wherein said coupons are distributed to different groups of customers (C. 1, L. 25-54).

It would have been obvious to one having ordinary skill in the art to modify Shermack to include that the benefit is transferable and can be shared by a plurality of

people, as disclosed in Mindrum, because it would advantageously attract new customers, thereby increase revenue.

Claims 59-64, 81-87, 102-105 and 108 are allowable.
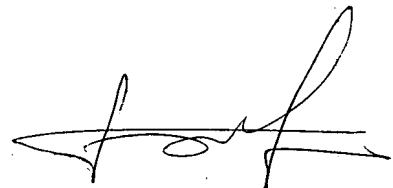
Response to Arguments

Applicant's arguments with respect to claims 1-12, 14-28, 88-101, 106 and 107 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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08/20/2007

IGOR N. BORISSOV
PRIMARY EXAMINER